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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,978	02/08/2002	Vincent J. Gatto	EP-7532	3784

7590 01/06/2005

Mr. Dennis H. Rainear
Patent & Trademark Division
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EXAMINER

JOHNSON, JERRY D

ART UNIT PAPER NUMBER

1764

DATE MAILED: 01/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Applicati n N .	Applicant(s)	
	10/067,978	GATTO, VINCENT J.	
	Examiner	Art Unit	
	Jerry D. Johnson	1764	

-- The MAILING DATE of this communication appears n the cover sh et with the c rrespondence address --

Peri d f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disp sition of Claims

- 4) ☒ Claim(s) 1,3,6-24,26-28,37-40,42 and 47-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 6-24, 26-28, 37-40, 42 and 47-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3, 6-24, 26-28, 37-40, 42, 47-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gatto et al. in view of Latyuk et al. and Belov et al.

Gatto et al., U.S. Patent 6,174,842, teach lubricating oil compositions comprising a major amount of an oil of lubricating viscosity comprising at least one oil-soluble molybdenum compound substantially free of reactive sulfur which provides about 50 to 1000 ppm of molybdenum to the lubricating composition, about 1000 to 20,000 ppm of at least one oil-soluble diarylamine and about 2,000 to 40,000 ppm of at least one alkaline-earth metal phenate detergent (column 3, lines 6-14). Oil-soluble molybdenum compounds are disclosed in column 4, line 48 to column 5, line 56. The composition of the lubricant oil can vary significantly based on the customer and specific application. The oil may contain, in addition to the three-component system according to the invention, a detergent/inhibitor additive package and a viscosity index improver (column 8, lines 53-57). The detergent/inhibitor additive package may include dispersants, detergent, zinc dihydrocarbyl dithiophosphates (ZDDP), additional antioxidants, pour point depressants, corrosion inhibitors, rust inhibitors, foam inhibitors and supplemental friction modifiers (column 8, lines 63-67). Generally, the ZDDP is present in the finished oil between about 0.25 and 1.5 wt.%. It is desirable from environmental concerns to have lower levels of ZDDP. Phosphorus-free oils contain no ZDDP (column 9, lines 28-31). The base oil may be selected from any of the synthetic or natural oils or mixtures thereof (column 9, lines 45-47). While Gatto et al. teach the addition of other functional additives, Gatto et al. differ from the instant claims in not teaching the claimed hydroxy-substituted dithiocarbamates.

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Latyuk et al. and Belov et al. are relied on as teaching hydroxy-substituted dithiocarbamates as claimed having good antiwear, antiscuff and anticorrosion properties as additives for lubricating oil compositions.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to add a hydroxy-substituted dithiocarbamate as taught by Latyuk et al. and Belov et al. to a lubricating composition as taught by Gatto et al. in order to improve the antiwear, antiscuff and anticorrosion properties of said lubricating composition.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18 and 49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 is a duplicate of claim 17.

Claim 49 states in line 3 that R, R' and R'' are alkyl groups, yet line 4 of the claim also defines R'' as R'''XCH₂ where X is oxygen, i.e., non-alkyl.

Applicant's arguments filed October 18, 2004 have been fully considered but they are not persuasive.

Applicant argues "Gatto et al. do not suggest the two component combination of a molybdenum source *per se* with a hydroxyalkyl-dithiocarbamate for any purpose in a lubricating or oil composition" and "neither Latyuk et al. nor Belov et al. indicate the compatibility of, nor that any unexpected results might be obtained by, combining a hydroxy-substituted

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dithiocarbamate with a lubricant per Gatto et al. containing an oil-soluble molybdenum compound.” (Remarks, pages 13 and 14).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that objective wear and oxidation stability data described in the instant specification are adequate to rebut any prima facie case of obviousness made against the present claims in the most recent Office Action (Remarks, page 14). Applicant further argues

[t]hese objective wear and oxidation stability data showing unexpected results, as described in the instant specification, specifically rebut the contention made in the Office Action that it would have been prima facie obvious to combine hydroxy-substituted dithiocarbamate and a molybdenum compound in a lubricant or oil-based composition.

These comparative data present in the instant specification also are both commensurate with the claimed scope of the invention and reasonably compare with the closest art. (Remarks, page 16).

Applicant's argument lack merit.

The burden of proving unexpected results rests on the party which asserts them. In proving such results, it is not enough just to show that certain results are obtained. The results to be probative of nonobviousness must be shown to have been unexpected to the skilled worker in the art. *In re D'Ancicco*, 439 F.2d 1244, 169 USPQ 303 (CCPA 1971); *In re Klosak*, 455 F.2d 1077, 173 USPQ 14 (CCPA 1972); *In re Juillard*, 476 F.2d 1380, 177 USPQ 1570 (CCPA

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1973). Moreover, it is axiomatic that evidence presented to rebut a prima facie case of obviousness must be commensurate in scope with the claims the evidence is offered to support. *In re Tiffin*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971).

Notwithstanding Applicant's arguments to the contrary, the showing in the specification is limited to compositions comprising specific amounts of a secondary ZDDP, a sulfur-free molybdenum compound derived from an organic amide and a hydroxyl substituted dithiocarbamate while the claims are not so limited. Accordingly, the showing is not commensurate in scope with the claims. Further, there is no evidence that the results are unexpected to the skilled worker in the art. Attorneys arguments unsupported by factual evidence do not take the place of objective evidence of unobviousness. *In re Lindner*, 173 USPQ 356.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

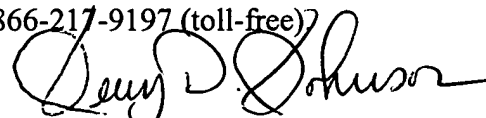
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry D. Johnson whose telephone number is (571) 272-1448. The examiner can normally be reached on 6:00-3:30, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jerry D. Johnson
Primary Examiner
Art Unit 1764

jdj